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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/454,252 12/02/99 PELLETIER

J 248/037

022249
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HM22/1115

EXAMINER

T.L.S.
ART UNIT

PAPER NUMBER

1653

DATE MAILED:

11/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/454,252

Applicant(s)

PELLETIER ET AL.

Examiner

Stephen Tu

Art Unit

1653

-- Th MAILING DATE of this communication app ars on th cov r she t with the corr spond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,16, 19, 21-23, 25-27, 32,33, and 35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1,9,16, 19, 21-23, 25-27, 32,33, and 35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 23, 25, and 26, drawn to a method of identifying an antibacterial agent derived from a bacteriophage, classified in class 435, subclass 6.
 - II. Claim 9, drawn to a method for identifying a target for antibacterial agents, classified in class 435, subclass 4+.
 - III. Claim 16, 21, and 22, drawn to an isolated nucleic acid sequence corresponding to a bacteriophage sequence, a recombinant vector and host cell, classified in class 536, subclass 23.1 and class 435, subclass 252.1.
 - IV. Claim 19, drawn to an isolated polypeptide with bacteria inhibiting properties, classified in class 530 and various subclasses thereof.
 - V. Claim 27, drawn to a method inhibiting bacterial growth, classified in class 514, subclass 14.
 - VI. Claims 33 and 35 drawn to a method of identifying or characterizing a bacteriophage ORF, classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

2. Invention I is unrelated to Invention II. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the Invention I is drawn to a method of identifying an antibacterial agent derived from a bacteriophage, whereas Invention II is drawn to a method of identifying the target of the agent

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identified by the method of Invention I. Clearly, these methods are directed to different functions, and would yield different results. Thus, these methods are not capable of use together and have different modes of operation, as each would involve different reaction conditions, as well as reaction components.

Inventions I and II are also unrelated to Inventions III-VI. The methods of Inventions I and II would be practiced using different reaction conditions and is drawn to a different result from Inventions III-V, which are drawn to the antibacterial agent, polynucleotides encoding the agent, as well as methods of using the agent.

3. Invention III and IV are patentably distinct from each other because of the materially different structures of the compounds claimed. Invention III is drawn to a polynucleotide, while the Invention IV is drawn to a polypeptide. The compounds that are the subject of each group are independent and/or patentable distinct from each other because each compound is structurally distinct. The compounds of each invention would be expected to exhibit different physico-chemical properties, and are capable of separate manufacture or use.

The term "distinct" means that two or more subjects as disclosed are related but are capable of separate manufacture, use, or sale as claims, and are patentable (novel and unobvious) over each other, though they may each be unpatentable because of the prior art (MPEP 802.01).

As for the method of inhibiting bacterial growth (Invention V), a variety of bacteristatic and bactericidal compounds are available to the skilled artisan that can be used to inhibit bacteria. Thus, the method may be practiced using other materially different compounds.

Inventions III-V are unrelated to Invention VI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention VI is drawn to a computer-based system of characterizing portions of a bacteriophage genome. The method of Invention VI involves a different mode of operation from that of Inventions III-V. The system is computer-based, and thus would not involve any of the reagents or processes that would be required to practice any of Inventions III-V.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by their different classification, the search required for one group would not be co-extensive with a search for any other Group. Therefore, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Wesley Ames on 1 November 2000 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Tu whose telephone number is 703-308-3968. The examiner can normally be reached on Monday-Friday, 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

ST
November 13, 2000

Karen Cochrane Carlson PhD

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER